

## REMARKS

This is a full and timely response to the outstanding final Office Action mailed May 4, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 112, Second Paragraph**

Claims 8, 23, 24, and 27-29 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

Regarding claim 8, the Examiner states that the claim is indefinite because “[i]t is not clear how receiving a decryption key can validate a flag”. Applicant respectfully submits that the meaning of that limitation is clear, particularly in view of Applicant’s original disclosure. As provided on page 15, for example, Applicant states:

When the printer has received the transmitted file, the encrypted portion or portions of the file may be decrypted. Decryption is effected by processor 52 of the printer (i.e., second device 36) in accordance with instructions provided by a decryption algorithm available thereto. Decryption may comprise either or user-initiated automatic activation of a single decryption algorithm available to the printer. Alternatively, decryption may be based on recognition by processor 52 of one or more of a source identifier or a flag that are part of the file header, or a decryption key that may be entered into the printer separately from the transmitted file (e.g., by way of input element 55). Such recognition may be required to activate a single decryption algorithm available to the printer, or to facilitate selection and activation of an appropriate decryption algorithm from a set of decryption algorithms that is available to processor 52.

*Applicant's specification*, paragraph 0057, lines 1-10.

In view of the above, Applicant discloses receipt of a “decryption key” with the printer to “activate” implementation of the decryption algorithm. Operating in that manner, decryption and printing of a received encrypted file may be delayed, even if the necessary decryption algorithm has been identified, until the recipient validates that decryption and printing may be performed. That way, output of a potentially sensitive document can be delayed until the recipient is present to receive the document.

In light of the foregoing, claim 8's recital of “validating said flag on the printer by receiving a decryption key with the printer that corresponds to said flag” is not indefinite and would be understood by a person having ordinary skill in the art, particularly after reviewing Applicant's specification. Applicant therefore has not amended claim 8.

Regarding claim 23, the Examiner states that the metes and bounds of the claim are unclear because the claim could be interpreted as implying that the recited “processor”, as opposed to a recited “decryption algorithm” is “associated with the encryption algorithm”. Applicant respectfully disagrees. The limitation of claim 23 at issue is the following (emphasis added):

at least one processor configured to receive an encrypted file for printing and configured to read an identifier provided in an unencrypted header associated with said encrypted file, the identifier providing an indication of an encryption algorithm that was used to encrypt said file, ***said at least one processor being configured to execute a decryption algorithm associated with the encryption algorithm*** to decrypt said encrypted file

The meaning of the phrase “said at least one processor being configured to execute a decryption algorithm associated with the encryption algorithm” is clear and unambiguous. Specifically, the phrase “associated with the encryption algorithm” directly follows the noun “decryption algorithm” and, according to the rules of English grammar, modifies that noun. Therefore, the phrase can only be properly interpreted as the “decryption algorithm” being “associated with the encryption algorithm”. Accordingly, Applicant has not amended claim 23.

In view of the above, it is respectfully asserted that claims 8, 23, 24, and 27-29 define the invention in the manner required by 35 U.S.C. § 112. Applicant therefore respectfully requests that the rejections to these claims be withdrawn.

## **II. Claim Rejections - 35 U.S.C. § 103(a)**

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or

references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

In the present case, there at least is no suggestion or motivation in the prior art to modify the references to include those limitations.

**A. Rejection of Claims 1, 2, 5, 7, 8, 10, 17, 19, and 20**

Claims 1, 2, 5, 7, 8, 10, 17, 19, and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mori* (U.S. Pat. No. 6,089,765) in view of *Goldstein* (U.S. Pat. No. 6,128,735). Applicant respectfully traverses this rejection.

In the Office Action, the Examiner argues that *Mori* teaches adding a header to a file that contains data to be printed and transmitting the file along with the header to a printer for printing of the data. The Examiner, however, acknowledges that *Mori* fails to teach encrypting the file and identifying the encrypting algorithm in the header. For that shortcoming, the Examiner relies upon the *Goldstein* reference, which is argued to teach a transmitted file that is encrypted with a header identifying the encrypting algorithm. The Examiner then concludes that, in view of the *Goldstein* reference, Applicant's claims are obvious. Applicant respectfully disagrees.

As described above, for a rejection under 35 U.S.C. § 103 to be proper, there must be some *suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art* to modify the reference. In this case, there is no such suggestion or motivation. Specifically, although *Mori* generally teaches transmission of a file to a printer for printing, *Mori* is not concerned with encryption at all. This is understandable given

that encryption is typically not used for files that are transmitted to a printer for printing. Although Goldstein discusses the use of encryption for transmitted files, Goldstein's disclosure relates to data communications in a "telecommunication system," not transmission of a file to a printer for printing. *See Goldstein*, column 1, lines 6-11. Although such encryption is common, even the norm, in such telecommunications, it is *not* common in relation to transmission of data files from a computer to a printer.

In view of the above, the applied references do not comprise the suggestion or motivation to apply Goldstein's telecommunication encryption to Mori's printing scenario. That missing link is only provided by *Applicant's own disclosure*. As is well established in the law, such hindsight to the Applicant's own disclosure is *per se* improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention). Accordingly, Applicant respectfully submits that the rejection is not proper under 35 U.S.C. § 103(a) and should be withdrawn as to each of claims 1, 2, 5, 7, 8, 10, 17, 19, and 20.

Turning to Applicant's dependent claims, neither reference teaches or suggests "providing said unencrypted header with a flag *recognizable solely by the printer* that identifies the encryption algorithm" as required by dependent claim 5 (emphasis added). Applicant notes that column 6, lines 22-27, which were identified by the Examiner, do not provide such a teaching. In particular, that excerpt is silent as to an identifier of an encryption algorithm being "solely" recognizable by the receiving printer or other device. Claim 5, as well as claims 7, 8, and 10 which depend therefrom, are allowable over Mori and Goldstein.

With further regard to dependent claim 8, neither Mori nor Goldstein teaches or suggests “validating” a flag provided in a received header by receiving a separate “decryption key” that corresponds to the flag. Regarding the Goldstein reference, which is relied upon as teaching that aspect, Goldstein says nothing of any additional decryption key. Column 4, lines 44-50 of the Goldstein reference identified in the Office Action describe no such decryption key received by a printer or other receiving device.

Regarding dependent claim 20, Applicant refers above to the discussion of the “decryption key” provided in relation to dependent claim 5.

**B. Rejection of Claims 3 and 21**

Claims 3 and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mori* in view of *Goldstein* and further in view of *Newton* (Harry Newton, “Newton’s Telecom Dictionary”). Applicant respectfully traverses this rejection.

As is identified above, Mori and Goldstein render Applicant’s independent claims obvious. In that Newton does not remedy the deficiencies of the Mori/Goldstein combination, Applicant respectfully submits that claims 3 and 21 are allowable over the Mori/Goldstein/Newton combination for at least the same reasons that claims 1 and 17 are allowable over the Mori/Goldstein combination.

**C. Rejection of Claims 4, 22-24, and 27-29**

Claims 4, 22-24, and 27-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mori* in view of *Goldstein* and further in view of *Menezes, et al.* (Alfred J.

Menezes, Paul C. van Oorschot, Scott A. Vanstone, "Handbook of applied cryptography", 1997, ISBN: 0849385237). Applicant respectfully traverses this rejection.

Because the Menezes reference does not remedy the deficiencies of the Mori/Goldstein combination, Applicant respectfully submits that claims 4 and 22 are allowable over the Mori/Goldstein/Newton combination for at least the same reasons that claims 1 and 17 are allowable over the Mori/Goldstein combination.

Turning to independent claim 23 and its dependents, the Mori and Goldstein references do not comprise the suggestion or motivation to apply telecommunication encryption to a printing scenario, as described above in relation to independent claims 1 and 17. Given that the Menezes reference, which is not concerned with computer/printer communications, does not provide the missing suggestion or motivation, Applicant respectfully submits that the rejection is not proper under 35 U.S.C. § 103(a) and should be withdrawn as to each of claims 23, 24, and 27-28.

With particular regard to dependent claims 28 and 29, Applicant notes that none of the references teach or suggest receiving an additional "decryption key" that corresponds to an "identifier" contained in a received header, wherein the decryption key "facilitates activation" of decryption using a decryption algorithm identified by the identifier. Applicant notes that the claimed "decryption key" is separate from the identified decryption algorithm and therefore must be separately taught by one of the references. Furthermore, Applicant disagrees that a decryption key, as defined by Applicant's disclosure, in addition to a decryption algorithm is needed to decrypt. For example, if the appropriate decryption algorithm is known, that is all that may be needed to decrypt. Such embodiments are both described in Applicant's specification and Applicant's claims. In claims 28 and 29, however, an additional decryption key that is provided to the printer is needed

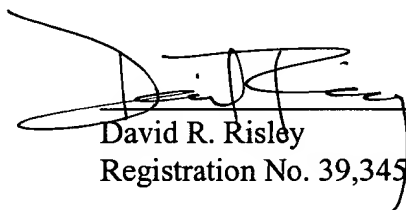
to “activate” decryption with the identified decryption algorithm. Such an arrangement is not taught or suggested by the references.



### CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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